

REMARKS

The Office Action of March 29, 2006 has been reviewed and the Examiner's comments carefully considered. The present Amendment modifies the specification in order to correct certain typographical and grammatical errors. No new matter has been added. Accordingly, claims 1-20 are pending in this application, and claims 1, 14, 15 and 17 are in independent form.

Initially, the Examiner has objected to claim 14 as being a substantial duplicate of claim 1. In this regard, the Examiner indicates that when two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. Applicants assert that claim 1 of the present application is directed to a loudspeaker diaphragm, which can be used in connection with a variety of loudspeaker types. Claim 14, on the other hand, is directed to a loudspeaker, and this loudspeaker includes a diaphragm. Clearly a claim directed to a loudspeaker diaphragm, which is a component of a loudspeaker, and a claim directed to a loudspeaker, which refers to the entire device, are different in scope and cover different structures. Accordingly, Applicants submit that claims 1 and 14 are not substantial duplicates. Withdrawal of this claim rejection is respectfully requested.

Pending claims 1-20 stand rejected. In particular, claims 1, 2, 4, 6-8 and 14 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,076,098 to Ward in view of Publication No. US 2002/0027997 to Watanabe. Claims 9-12, 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Ward patent in view of the Watanabe publication, and in further view of Publication No. US 2002/0045040 to Kanada. Further, claims 3 and 17-20 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Ward patent, the Watanabe publication, the Kanada publication, and in further view of U.S. Patent No. 5,055,341 to Yamaji. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being obvious over the Ward patent and the Watanabe publication, and in further view of European Patent No. 0508596 (hereinafter "EP '596"). Finally, claim 5 stands rejected under 35 U.S.C. § 103(a) as being obvious over the Ward patent in view of the Watanabe publication, in further view of U.S. Patent No. 6,378,649 to Inoue, and in still further view of

U.S. Patent No. 5,744,761 to Ogura. In view of the following remarks, Applicants respectfully request reconsideration of these rejections.

The Cited Prior Art

The Ward patent is directed to a loudspeaker diaphragm, as well as methods of making such diaphragms. The Ward patent serves as a primary reference in all of the obviousness-type rejections of the Examiner. In addition, the Watanabe publication is also used as a primary reference in all of the rejections. The Watanabe publication is directed to a structure and method of absorbing and shielding sound. In particular, the Watanabe publication describes structures and methods for absorbing and shielding sound for use “as a sound absorbing and shielding material of an automotive vehicle.” Watanabe publication, ¶ [0005]. All of the Kanada publication, Yamaji patent, EP ‘596, Inoue patent and Ogura patent serve as secondary references in the Examiner’s rejections of various of the pending claims. The Kanada publication is directed to microporous soundproofing materials, and the Yamaji patent is directed to composite molded articles and processes for producing such articles. Further, EP ‘596 is directed to an electroacoustical transducer. Finally the Inoue patent is directed to a speaker member and manufacturing method thereof, and the Ogura patent is directed to a diaphragm-edge integral molding for speakers and acoustic transducers.

The Test for Obviousness

“The Supreme Court has frequently warned against the use of ‘hindsight’ in determining obviousness. ... It is impermissible to use the inventor’s disclosure as a ‘road map’ for selecting and combining prior art disclosures.” Chisum on Patents, §5.03[2][c], p. 5-105 - 5-109 (Rel. 90-11/03). *See, e.g., Crown Operations Int’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002). Further, the Examiner cannot use the claims as a blueprint for locating separate claim elements in separate prior art references without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *See also In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965)(“it is impermissible...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of

ordinary skill in the art.”) In particular, “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Still further, as set forth in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art.

In the absence of some “clear and particular” motivation to combine the teachings of the cited prior art, the rejection is improper. *Winner Int’l Royalty Corp. v Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000). “Numerous decisions emphasize that such a combination of reference teachings is improper unless the prior art suggests such a combination.” *Chisum*, § 5.04[1][d], p. 5-278. *See, e.g., In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *Ecolochem, Inc. v. Southern Calif. Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000)(“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.”)

When determining the level of ordinary skill in the art, the inventor’s actual knowledge and skill is not determinative, instead the focus should be on the skill of a hypothetical person of ordinary skill aware of the prior art teachings. *Chisum*, § 5.03[4][e][i], p. 5-228; *Ex Parte Anderson*, 21 USPQ2d 1241, 1256 (Bd. Pat. App & Int’f 1991).

The statutory emphasis is on a person of *ordinary* skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something - call it what you will - which set them apart from the workers of *ordinary* skill, and one should not go about determining obviousness under § 103 by inquiring into what *patentees* (i.e., inventors) would have known or would likely have done, faced with the revelations of the references. A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.

Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454 (Fed. Cir. 1985).

Claims 1-20 of the Present Invention are not Obvious in View of these Cited References

As discussed above, the Examiner has used the Ward patent and the Watanabe publication as the primary references for each of the Section 103 rejections of the claims. In particular, the Examiner uses the Ward patent and the Watanabe publication to reject

independent claims 1 and 14, and the Ward patent, the Watanabe publication and the Kanada publication to reject independent claim 15. In addition, the Examiner has combined the Ward patent, the Watanabe publication, the Kanada publication and the Yamaji patent to reject independent claim 17. Therefore, the Examiner has combined two references to reject independent claims 1 and 14, three references to reject independent claim 15 and four references to reject independent claim 17.

First, with respect to the Watanabe publication, Applicants respectfully submit that this reference is not combinable with the remaining references to formulate such rejections. Specifically, the Watanabe publication is directed to structures and methods for absorbing and shielding sound within an automotive vehicle. Still further, the teachings of the Watanabe publication are specifically directed to sound absorbing and shielding structures used as a dashboard insulator in such vehicles. Therefore, the technical field of the Watanabe publication is clearly different from the technical field (loudspeaker diaphragm construction) of the present invention. One of ordinary skill in the art of loudspeaker diaphragms would not be motivated to combine the teachings of the Watanabe publication for vehicle sound absorption, with the loudspeaker diaphragm of the Ward patent. Accordingly, there is no “clear and particular” motivation to combine the teachings of the Watanabe publication and the Ward patent, and as such, the rejection is improper. Withdrawal of the rejection of claims 1, 14, 15 and 17 is respectfully requested.

Further, it is noted that the Examiner has used numerous prior art citations in rejecting the various claims of the present application. Notwithstanding the improper use of the Watanabe publication, Applicants submit that the Examiner is using the claims as a blueprint for locating separate claim elements in separate prior art references without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. Again, there is no incentive to combine the references together in order to arrive at the subject matter of the present application. Still further, the claimed invention should not be used as an instruction manual or a “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Accordingly, on this further basis, Applicants respectfully request reconsideration of the rejections of independent claims 1, 14, 15 and 17.

Summary

For the foregoing reasons, independent claim 1 is not rendered obvious over the Ward patent, the Watanabe publication or any of the prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 1 is respectfully requested.

Claims 2-13 and 20 depend either directly or indirectly from and add further limitations to independent claim 1 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 1. Further, many of these claims have been rejected over a number of prior art references used in combination, and Applicants again submit that such a combination could not be arrived at without the improper use of the Watanabe publication. Therefore, for all the above reasons, reconsideration of the rejections of claims 2-13 and 20 is respectfully requested.

Independent claim 14 is not rendered obvious over the Ward patent, the Watanabe publication or any of the prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 14 is respectfully requested.

For the foregoing reasons, independent claim 15 is not rendered obvious over the Ward patent, the Watanabe publication, the Kanada publication or any of the prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 15 is respectfully requested.

Claim 16 depends directly from and adds further limitations to independent claim 15 and is believed to be allowable for the reasons discussed hereinabove in connection with independent claim 15. Therefore, reconsideration of the rejection of dependent claim 16 is respectfully requested.

For the above reasons, independent claim 17 is not rendered obvious over the Ward patent, the Watanabe publication, the Kanada publication, the Yamiji patent or any of the prior art of record, whether used alone or in combination. There is no hint or suggestion

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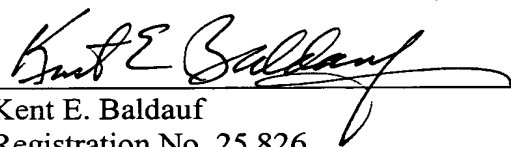
in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 17 is respectfully requested. Claims 18 and 19 depend either directly or indirectly from and add further limitations to independent claim 17 and are believed to be allowable for the reasons discussed hereinabove in connection with independent claim 17. Therefore, reconsideration of the rejections of claims 18 and 19 is respectfully requested.

For all the foregoing reasons, Applicants believe that claims 1-20 are patentable over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 1-20 are respectfully requested.

Respectfully submitted,

THE WEBB LAW FIRM

By



Kent E. Baldauf
Registration No. 25,826
Attorney for Applicants
700 Koppers Building
436 Seventh Avenue
Pittsburgh, Pennsylvania 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com